

JUL 19 2004

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Patent Application
Attorney Docket No. A0592Q-US-NP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Santokh S. Badesha, et al.

Application No.: 09/737,413

Filed: December 14, 2000

Examiner: Lawrence D. Ferguson

Art Unit: 1774

Title: Transfix Component Having Mica-Type
Silicate Outer Layer

Mail Stop Appeal Brief -Patents
Commissioner for Patents
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Sir:

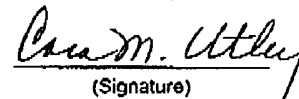
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REPLY BRIEF

With reference to the Examiner's Answer dated April 21, 2004, Appellants continue to be of the positions as detailed in the Appeal Brief filed January 12, 2004.

Appellants strongly urge the Board to pay close attention to the specific language included in the parts of the references, which the Examiner relies upon for the obviousness arguments. With all due respect to the Examiner, Appellants respectfully submit that the Examiner has inadvertently misinterpreted these sections. The Examiner cannot take statements from the prior art reference out of context and give them meanings contrary to what they would be given by one of ordinary skill in the art, in order to make a case of obviousness. In re Wright, 9 USPQ2d 1649 (Fed. Cir. 1989).

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A. Badesha et al. '643 in view of Swift et al.

Regarding the rejection of claims 1-10 and 13-21 over Badesha et al. '643 in view of Swift et al., it is important that the Board note that the claims are not product by process claims. Instead, the claims are directed to an image forming apparatus and to components of that apparatus. The components of the apparatus are not taught or suggested by the cited art. Specifically, a *prima facie* case of obviousness has not been made because neither of the references, alone or in combination, teach the claimed apparatus including the three member transfer combination of 1) a transfer component, 2) an intermediate transfer component, and 3) a transfix component.

1) Badesha et al. '643 does not teach a transfer member, an intermediate transfer member or a transfix member.

Appellants submit that the teaching in Badesha et al. '643 at column 1, lines 16-48, of exposing a light image, developing and transferring to a support surface for fusing, is not a teaching of a transfer member. This is merely a teaching of a method of transfer, followed by fusing a developed image.

The Examiner maintains that the teaching in Badesha et al. '643 of an "intermediate support layer in a fuser member" (column 3, lines 44-45) is a teaching of an intermediate transfer member. (Reply Brief, pg. 3, last line). This is only a teaching of an intermediate layer in a fuser member, and not to an intermediate transfer member.

2) Swift et al. does not teach a transfer member.

Swift et al. teaches a transfer station comprising an intermediate transfer member and a fuser or transfix component (col. 4, lines 39-47). However, Swift et al. does not teach the recited transfer member in combination with transfix and intermediate transfer member.

The Examiner continues to take the position that the Swift et al. disclosure of "The transfer station includes an intermediate transfer belt that receives a toner from latent image and transfers that toner to the fuser or a transfix member" is a teaching that a fuser member and a transfer member are interchangeable. Appellants

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request that the Board view this teaching as it stands, and not to interpret with additional words or meaning other than what it states. The statement just says that toner can be transferred to a fuser member or to a transfix member. The statement does not include a recitation that the members are interchangeable. Again, Appellants point out that the Examiner cannot take statements from the prior art reference out of context and give them meanings contrary to what they would be given by one of ordinary skill in the art, in order to make a case of obviousness. In re Wright, 9 USPQ2d 1649 (Fed. Cir. 1989).

The Examiner later makes a contrary statement and admits in the Examiner's Answer that Swift et al. does not teach a transfer member as follows. The Examiner states that although Swift et al. teaches a transfix component and not a transfer member, "although named differently, the same function is practiced". Later, the Examiner states that the transfix member is the transfer member (Examiner's Answer, page 10, lines 4-5). Contrary to this assertion, Appellants assert that a transfer member has a different function than a transfix member. A transfer member transfers a partially or fully developed image to another transfer member or to an intermediate transfer member. A transfer member does not fuse an image. A transfix member transfers a fully developed image to a copy substrate (such as paper) and fuses that image to the copy substrate. The members perform different functions, and require different mechanical, electrical, chemical and other properties for their coatings so that they can perform the diverse functions.

Later in the Examiner's Answer, the Examiner states that a fuser member and a transfix member, "although not named the same" are functional equivalents (Examiner's Answer, page 11, lines 5-7). Appellants point out that a fuser member fuses a toner image to a copy substrate, and does not participate in any way in transfer of the developed image. On the other hand, a transfix member transfers the image, and fuses the image to a copy substrate.

Appellants note that the Examiner has made statements that transfer members and transfix members are the same, "although named different," and that transfix members and fuser members are the same "although named different."

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(Examiner's Answer, page 10, lines 4-5 and page 11, lines 5-7). Appellants strongly submit that these three components of an imaging apparatus do not all have the same function.

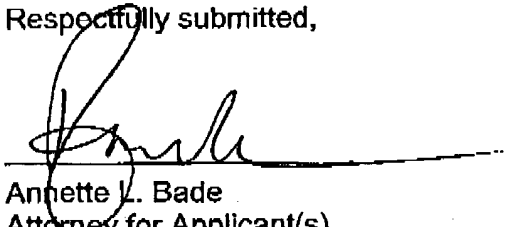
Therefore, Appellants submit that the combination does not teach or suggest the three transfer member combination of 1) transfer member, 2) intermediate transfer member, and 3) transfix member.

B. Badesha et al. '643 in view of Badesha et al. '504

At page 12, lines 13-15 of the Examiner's Answer, the Examiner brings into the rejection teachings of Swift, et al., in order to make a *prima facie* case of obviousness. Appellants point out that Swift, et al. was not part of this original rejection of claims 1-17 and 20-21. Appellants submit that it is inappropriate to rely on teachings of this tertiary reference not contained in the original rejection, especially at this late stage in prosecution. Appellants submit that a new ground of rejection has been made, and it is inappropriate to state a new ground of rejection in a Reply Brief. (MPEP §1208.01).

In the event the Examiner considers personal contact advantageous to the disposition of this case, s/he is hereby authorized to call Annette L. Bade, at Telephone Number 310-333-3682, El Segundo, California.

Respectfully submitted,



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July 19, 2004

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